

REMARKS

This Provisional Election and Request for Reconsideration is submitted in response to the outstanding Office communication dated June 25, 2003.

Applicants provisionally elect those claims which are directed to a method of making filter elements; identified by the Examiner as Invention I comprising claims 1-12. The Examiner has also identified Invention II as being directed to apparatus claims 13-19 and Invention III as being directed to a filter element, claim 20.

The Examiner has alleged that **Inventions I and III** are distinct from each other. The basis for that conclusion is:

"...The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP 806.05(f)). In the instant case that the process as claimed can be used to make other and materially different product, such as ceramic pipes, and the product can be made by injection molding."

Thus, it is seen that the determination that the process and product are distinct is based solely on the unsupported opinion by the Examiner, that a) the process as claimed can be used to make other and materially different product such as ceramic pipes, and b) the product can be made by injection molding.

Referring first to a), the Examiner has ignored the fact that the process claims are directed to an improvement in a method for making filter elements. It is ludicrous to assert that an improvement in a method for making filter elements can result in the creation of a ceramic pipe or other materially different product.

Further, the claimed method comprises mixing carbon and binder. Does the Examiner believe that the manipulative steps can possibly create a ceramic material from carbon and binder? It is submitted that alchemy is no longer an accepted science.

Referring now to b), the Examiner has stated that "the product can be made by injection molding". Let us look into nature of the claimed product. Claim 20 relates to a filter element . . . wherein the density of the porous structure increases in a direction from the periphery thereof to the center of the structure. Having conceived that it would be desirable to be able to manufacture a filter having the aforesaid structure, the inventors hereof developed apparatus which employs the claimed process of claims 1-12. The inventors are skilled in this art. Had it been possible to simply injection mold such a structure, does the Examiner believe that the inventors would have

gone to the trouble of making the claimed apparatus developments? Why would anyone go to such trouble, and then waste precious assets to protect such process and apparatus by patents (for if the Examiner were correct competitors could simply circumvent any process or apparatus claims by using injection molding techniques)?

The Examiner is also requested to review his holding that **Inventions I and II** (which relate to process and apparatus) are distinct. The basis for this holding is that "the apparatus as claimed can be used to practice another and materially different process, like making ceramic pipes". This statement is most interesting, since it recognizes that the process claims are limited to making filter elements (as Applicants have pointed out above), despite the Examiner's separately stated holding: "In the instant case that the process as claimed can be used to make other and materially different product, such as ceramic pipes."

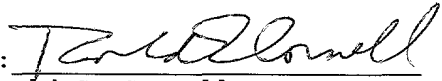
The Examiner is also requested to review his holding that **Inventions II and III** (which relate to apparatus and product) are distinct. The Examiner has stated that these groups can be held distinct if a) 1- the apparatus is not an obvious apparatus for making the product and 2- the apparatus can be used for making a different product or b) the product can be made by another and materially different apparatus. The Examiner concludes (erroneously) that A. an extruder is not an obvious apparatus for making filter elements, and B. the product can be made by injection molding.

Referring to A., it is well known that filter elements can be made using extruding apparatus. Indeed, reference is made in the specification to several patents describing useful extruding devices, e.g., 5,189,092 and 5,249,948.

Referring now to B., we get back to the discussion above in which it was pointed out that there is no way know that injection molding can form the claimed product in which the density varies in a specific manner.

Taking into account the arguments set forth above, it becomes clear that the restriction requirement is based upon unsupported speculations. The requirement should be withdrawn and action on all of the claims be given.

Respectfully submitted,
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